



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,628	06/26/2001	Narinobu Kagami	209081US0PCT	4073
22850	7590	01/06/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			NGUYEN, CAM N	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 01/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,628

Applicant(s)

KAGAMI ET AL.

Examiner

Cam N Nguyen

Art Unit

1754

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 21, 2004 (an amendment/response).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 36-38 is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 3 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1754

DETAILED ACTION

1. Applicants' remarks and amendments, filed on December 21, 2004, have been carefully considered. Claims 1 & 4 have been amended. Claims 5, 9-34, & 38-59 are canceled.

Claims 1-4, 6-8, & 35-38 remain pending in this application and under consideration.

2. It was indicated in previous office action that claims 1-4, 6-8, & 35-38 would be allowed since they contained allowable subject matter. Unfortunately, in view of the newly submitted IDS references dated August 23, 2004, it appears that one of the US references, which is patented to Yanik et al. (US Pat. 4,080,286), reads on the instant claims 1-2 & 6-8. Thus, this reference is applicable under 35 USC 103(a) for these claims. A new ground of rejection follows.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1754

4. Claims 1-2 & 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanik et al., "hereinafter Yanik", (US Pat. 4,080,286).

Yanik discloses a catalyst substantially free of phosphates and consisting essentially of a hydrogenating metal selected from Group VI-B and a hydrogenating metal selected from Group VIII, both hydrogenating metals being in a sulfided form, supported on a non-zeolitic refractory oxide carrier and promoted with from about 1 to about 10 weight percent of a Group IV-B metal by the addition of the Group IV metal to said carrier after calcination of said carrier; the improvement which comprises in the preparation of said catalyst the step of adding the titanium to said carrier by contacting said carrier with an aqueous solution of a titanium salt (see col. 6, claim 1, ln 9-21). Yanik further discloses that the carrier is contacted with the aqueous solution of a titanium salt simultaneously with compositing said Group VI and Group VIII hydrogenating metals with said carrier (see col. 6, claim 9). The non-zeolitic refractory oxide carrier is selected from a group including alumina (see col. 6, claim 10). The heating temperature is 121°C for drying and 538°C for calcining (see col. 4, Example 1). Molybdenum and Nickel are being exemplified for Group VI and Group VIII hydrogenating metals (see col. 4, Example 1).

Regarding claim 1, applicants claim a "heating temperature of being not higher than 300°C". The phrase "heating temperature" in the claim is taken to mean the final temperature or calcination temperature. If in fact, applicants means the drying temperature required being not higher than 300°C then the claim is met by the teaching of the Yanik reference because Yanik teaches a drying temperature of 121°C. If in fact,

Art Unit: 1754

applicants means the calcination temperature required being not higher than 300°C then it would have been *prima facie obvious* to one of ordinary skill in the art at the time the invention was made to have optimized such heating temperature in the process of Yanik in view of In re Boesch.

Regarding claim 2, the claim is met by the teaching of the reference because Yanik teaches titanium compound (see above).

Regarding claim 6, the claimed titanium range is met by the teaching of the reference since the disclosed range fall within the claimed range (see above).

Regarding claim 7, Mo and Ni are disclosed by the reference, thus meets the claim (see above).

Regarding claim 8, since Yanik teaches that the catalyst contains phosphates in the amount of less than about 0.1% as contamination (see Yanik at col. 1, ln 45-50), thus provides for the catalyst carries phosphorus, thus meets the claim.

Allowable Subject Matter

5. Claims 3 & 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Amendment/Arguments

6. Applicants' amendment/response filed on December 21, 2004 has been fully reconsidered, but not deemed persuasive in view of the new ground of rejection above.

Art Unit: 1754

Conclusion


7. Claims 1-4, 6-8, & 35-38 are pending in the application. Claims 1-2 & 6-8 are rejected. Claims 3 & 35 are objected. Claims 4 & 36-38 are allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cam Nguyen, whose telephone number is (571) 272-1357. The examiner can normally be reached on Mon, Wed, Thurs, & Fri from 8:45 am. to 5:15 pm.

The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to telephone number (571) 272-1700.

Nguyen/cnn


CAM N. NGUYEN
PRIMARY EXAMINER

January 05, 2005

Art Unit: 1754